

No. 15249

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

C. S. JOHNSON COMPANY,

Plaintiff-Appellant,

vs.

MERLE W. STROMBERG, dba CALIFORNIA BATCHING
EQUIPMENT Co., DOE I, DOE II, and DOE III,

Defendant-Appellee.

REPLY BRIEF FOR PLAINTIFF-APPELLANT.

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REPLY BRIEF FOR PLAINTIFF-APPELLANT.

The Brief of the Defendant-Appellee demonstrates uncertainty that the prior use defense will be sustained and prudently discusses other possible defenses not seriously urged at the trial.

We submit this reply organized in terms of issues in the case.

Statement of the Case.

The Trial Court's Decision.

Defendant claims (His Brief, p. 2) that the District Court expressly refused to determine, in the absence of the alleged prior public use, whether the Johnson patent was valid or infringed. Page 648 *et seq.* of the Transcript contains only an expression of the Court's desire to make sure what is invention, followed by an explanation of Defendant's counsel as to what he thought was or was not invention. Defendant makes no attempt to explain the Court's twice expressed statement [Tr. p. 650] that he was basing his decision on "*all the evidence in the case.*"

POINT I.

The Testimonial Record Is Highly Persuasive of Invention.

Johnson's Patent Discloses a New Batching
Apparatus Having a New Result.

Among other things, Defendant is now trying to sustain a "Lack of Invention" defense. (His Brief, p. 2.) Without explanation and without attempt to apply them, he cites *A & P Tea Co. v. Supermarket Corp.*, 340 U. S. 147; *Park-In-Theatres v. Perkins*, 190 F. 2d 137; *Himes v. Chadwick*, 199 F. 2d 100; *Kwikset Locks v. Hillgren*, 210 F. 2d 483; and *Photochart v. Photo Patrol*, 189 F. 2d 625. None of these citations appears to be pertinent. The only thing common to them seems to be that in each instance an invention combining old elements was found not patentable because it failed to perform some new or different function. That is hardly the case here.

In our Main Brief we pointed out how the record established that Johnson taught the concrete batching art a new concept in batching apparatus by providing a concrete weigh batcher which would *intermingle* or *premix* the cement and aggregates at the discharge opening as they were discharged. Also pointed out were the many important advantages of intermingling the ingredients at the discharge opening. Detailed references were made to the record transcript to support the assertions. Stromberg now baldly says that the assertions do not represent the evidence as actually presented in the record, without attempting to point out a single instance of misrepresentation.

Instead, Stromberg argues, without explaining, that *premixing* or *intermingling* was not Johnson's contribution to the art because of Johnson's earlier patent No. 1,687,499, a file reference to the patent here in suit. Nowhere in that patent is there the slightest suggestion

of *premixing* or *intermingling* the ingredients. Instead, a ribboning or stratified feed is taught. The only other patent, Robb No. 1,750,244, relied upon by Stromberg at the trial has now seemingly been cast aside, no reference being made to it in Defendant's Brief.

Defendant's reliance upon the testimony of Pearman for establishing that there is no such *premixing* or *intermingling* is sheer nonsense. The closest scrutiny of Pearman's testimony [particularly Tr. pp. 255-257, 263-264, mentioned by Defendant] discloses not a word to that effect. What Pearman really did say was that any plant would give a good mix "but it may take just a little longer" under certain conditions [Tr. p. 256]. This was quite a concession from Pearman who was the owner of the infringing Stanton plant and obviously not friendly to Plaintiff.

Defendant tries to ignore that the Trial Court said he was "convinced" [Tr. pp. 366-367] that the aggregate and cement "commingled" at the discharge of the Stanton plant weigh batcher [Pltf. Ex. 14], which weigh batcher is strikingly similar to that illustrated in Johnson's patent.

The use of new elements in Johnson's invention is also ignored by Defendant. The record is devoid of evidence showing that a weigh hopper constructed to receive another independently moveable weigh hopper was old.

Defendant's manufacture and sale of batchers incorporating Plaintiff's invention is, by itself, evidence of invention.

Also, the commercial success of Plaintiff's invention appears to have been conceded. Defendant's Brief avoids discussion of the subject. This fact and the wide variety of the prior art devices shown in Defendant's Exhibit B are likewise indicia of invention. (*Stearns et al. v. Tinker & Razor et al.* (9th Cir., 1955), 220 F. 2d 49.)

Validity of the Claims.

Defendant's assertion that the claims do not define patentable subject matter under the doctrine of *Reckendorfer v. Faber*, 23 L. Ed. 719, and *Willard, et al. v. Union Tool Co.*, 253 Fed. 48, is little short of frivolous. In the *Reckendorfer* case the pencil lead was used by itself, the eraser was used by itself and neither could be used together. In the *Willard* case the patentee was claiming in combination with a rotary drilling table a detached manually movable tool which was not used during the normal operation of the rotary table. Both sharply contrast with Johnson's weigh batcher where the two hoppers perform their weighing and discharging functions simultaneously and cooperate towards a single end, the premixing or intermingling of the cement and aggregates as they are discharged.

Defendant also seeks some comfort in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 93 L. Ed. 672, citing it in support of the proposition that "a new element or limitation cannot be read into a claim which would otherwise be invalid." Again, the pertinency of the cited case is not seen, particularly because there has been no showing that the claims "otherwise are invalid."

Defendant seeks to criticize Plaintiff's expert witness, Wright, for having made no tests. Defendant's own expert witness, Wisniski, without the benefit of tests was convinced that "with a better dispersion of materials, you probably wouldn't have to mix as long," and that where the cement is put in on top "they do get some building up of cement on the blades, I think, more than you would if you partially fed that cement in with the rest of the ingredients." [Tr. p. 440.]

POINT II.

The Trial Court Erred in Finding the Evidence on the Apparatus at 235 Alabama Street, to Be Such, as a Matter of Law, as to Invalidate Claims 1 and 5 of Johnson Patent No. 2,138,172.

As pointed out in our Main Brief, pages 5-9, Johnson taught the art how to make a concrete weigh batcher which provided for *accurate* cement weighing and *pre-mixed* or *intermingled* the cement and aggregates *at the discharge* of the weigh batcher to *substantially eliminate dusting and gumming, pre-shrink the batch, and reduce the mixing time required in the concrete mixer.* The radical departure that was made from prior art structures is best represented by comparison with the devices of the prior art [Deft. Ex. B] which widely differ in construction and function and are presumably the best prior art found by Defendant.

In his Reply Brief Defendant continues to urge that an alleged prior public use of a belatedly found weigh batcher invalidated Johnson's claims 1 and 5, although Defendant's own witnesses proved that the alleged apparatus did not bring to the art the teaching that Johnson did.

Murasko's Testimony.

On pages 23 and 27 of our Main Brief we pointed out that Murasko did not even suggest that the Alabama Street batching apparatus premixed or intermingled the concrete ingredients as they were discharged. We also pointed out that Murasko said it made no difference as to how the ingredients were introduced into the small one yard mixer they had at that plant. Defendant's Brief says nothing to the contrary. Also, Defendant makes no attempt to explain Murasko's statement that Cornett operated the plant "probably for six years before I left

there" [Tr. p. 515], which statement in effect means that Cornett never saw the apparatus until 1936, a date too late to invalidate. (Our Main Brief, pp. 23-24.)

Cornett's Testimony.

Plaintiff's attempt to obtain some conflict in Cornett's testimony was successful. As we pointed out (our Main Brief, pp. 23-24) Cornett made it very clear that he and Murasko worked together (in the sense that they worked for the same company) for a period of 12 years, and that it was only a period of 6 years during which he worked as an operator in the plant with Murasko as his superintendent [Tr. pp. 591-592]. Cornett made it very clear that he worked inside the batching plant in no other capacity.

Defendant makes no attempt to explain the above. Instead he asserts without explanation that we have a misconception of the testimony, and that the correct interval is the unsupported 1933-1942 interval testified to on page 530 of the Transcript. If this 9 year interval were correct, it remains to be explained why Cornett said that "nine years" didn't mean a thing to him [Tr. p. 593].

More importantly, Defendant's Brief is silent about Cornett's having been quite positive in stating that the cement and aggregate did not intermingle or mix at the discharge gate and *only mixed down in the chute*. (Our Main Brief, p. 24.)

Bodinson's Testimony and the Documentary Evidence.

In our Main Brief, pages 25-26, we pointed out that Bodinson testified that he had nothing to do with Defendant's Exhibits A and F through P at the time they were made, that he had never compared them with the Alabama Street plant, and that the batching apparatus was

covered with galvanized sheeting. We also pointed out a number of instances in which the Documentary Exhibits did not conform to the testimony, particularly pointing out that Defendant's Exhibit K indicates that the Alabama Street plant had a single hopper containing an *integral cement compartment* instead of a *separate cement hopper*.

Defendant's only comment (His Brief, p. 9) regarding the above is that our "interpretation of Exhibit K is erroneous and not in accord with any of the testimony in the record." Of course it's not in accord with any of the testimony. No attempt whatever is made to explain why the interpretation is erroneous.

The Conflicting Evidence Relating to the Alabama Street Plant Does Not Support the Findings of Fact.

On pages 27-29 of our Main Brief we pointed out how the conflicting evidence did not support many of the Findings of Fact made by the Trial Court. Defendant's argument to the contrary (His Brief, p. 9) is surprising and inaccurate.

As concerns the premixing or intermingling action, Defendant continues to claim "the record fails to establish that in any Johnson-type plant such action takes place." However, the Stanton plant [Pltf. Ex. 14] is clearly a "Johnson-type" plant and as to it the Court was "convinced" that the materials "commingled" [Tr. p. 367]. According to Webster's New International Dictionary (2d Ed., 1956), "commingled" is defined—"to mingle together; to mix intimately; blend."

Defendant further argues that his infringing "structure follows the teaching of the prior art." What prior art? Certainly not that of the alleged Alabama Street plant. Defendant makes no claim of knowing about that apparatus more than a week prior to the trial.

Defendant's conjecture to the effect that mounting the cement gate air ram on springs would not adversely affect the ability of the hoppers to move independently is preposterous. His own witness, Cornett, testified that this construction would affect the setting on the scales [Tr. p. 596]. Moreover, if so little effort is required to actuate a gate there would appear to be little sense in using an air ram to provide the effort.

Regarding his having met the required burden of proof, Defendant places his sole reliance upon *Whiteman v. Mathews* (9th Cir., 1954), 216 F. 2d 712. The facts of that case are readily distinguished from those of the instant case, and we also submit that the Defendant has failed to meet the test set forth in that case. (Our Main Brief, p. 20.)

In the *Whiteman v. Mathews* case (*supra*), the following conditions existed—(1) There was no question about the details of the anticipating device which was in the courtroom. (2) Spencer, the man who made the device was called as a witness. (3) The device was used publicly at various jobs. (4) Some of the plaintiff's witnesses testified that they had seen the anticipating device only two years after the year it was alleged to have been used. (5) Spencer's testimony was not contradicted on any important point, and (6) There was no question about Plaintiff having notice of the device prior to trial.

None of the above conditions are found in the instant case, instead (1) There is considerable doubt about the construction of the alleged anticipating device which, according to Defendant's witness, was destroyed nine or ten years ago; the only physical evidence regarding it was some conflicting drawings and papers alleged to have been found in the files of an equipment manufacturer. (2) The maker of the device did not testify. (3) The alleged device was screened from public view. (4) The

Defendant himself made no claim of knowing about the device more than a week prior to the trial. (5) There was considerable contradiction in and between the testimony and documentary evidence, and (6) There was no opportunity to prepare for the surprise evidence.

Defendant (His Brief, pp. 5-6) tries to find some comfort in the fact that Plaintiff offered no evidence to the contrary regarding the alleged Alabama Street plant. Plaintiff did not have to because Defendant's own witnesses offered more than enough evidence to the contrary. Defendant also claims (His Brief, p. 6) that we have not pointed to any evidence in the record tending to disprove the construction of the Alabama Street plant—almost as if pages 22-29 of our Main Brief had not been written.

The Validity of Claims 1 and 5 Is Clear. Defendant Himself Argues for Lack of Anticipation.

In our Main Brief, pages 30-32, we pointed out why the evidence does not invalidate the claims. The discussion included a detailed explanation as to why the Alabama Street apparatus, if it existed, fails to meet specific claim requirements. Defendant counters by calling the inadequacies and conflicts of the record “so-called inconsistencies” which don't detract from the fact that the Alabama Street plant included the claimed combination. Invalidating claims would indeed be a simple matter if the short comings of one's proof could be overcome by the simple expedient of terming them “so-called inconsistencies.”

We have also pointed out how the alleged Alabama Street apparatus failed to teach the “commingling” action taught by Johnson and the benefits that flowed therefrom. In this respect the Defendant now makes a vital argument in our favor. In his Brief, page 15, he argues there

is no infringement because "If the claims are to be interpreted, as appellant contends, as limited to a device wherein the so-called premixing or intermingling occurs, then this is not present in appellee's structure according to appellant's own witness Pearman."

Defendant is arguing for a double standard of claim interpretation, one standard for validity and a second for infringement. We submit that this is fatal to his case. He cannot contend that the Stanton plant does not infringe because it has no premixing or intermingling, and at the same time argue that the same claims are anticipated by an apparatus which did not have premixing or intermingling. If a device does not infringe, if earlier, it would not anticipate. (*Charles Peckat Mfg. Co. v. Jacobs* (7th Cir., 1949), 178 F. 2d 794.)

POINT III.

The Trial Court Clearly Abused Its Discretion by Admitting Any Evidence Relative to the Alabama Street Plant, Despite Lack of Notice Under 35 U. S. C. 282.

The law (35 U. S. C. 282) which the trial judge was administering and applying in the present case is a rule of procedure relating to notice. This, as stated in our opening brief at page 37, is an important right and no technicality. Important reasons behind the law are to *prevent delays* (*The Philadelphia and Trenton Railroad Co. v. Stimpson*, 39 U. S. 448 at 459, 14 Peters 535 at 541 (1840), page 37 of our opening brief) and to give a plaintiff an opportunity to adequately *prepare for cross-examination*. That preparation for cross-examination was particularly important in the present case was pointed out on page 39 of our opening brief. In McCormick, Evidence, 1954 Edition at page 57, it is stated that "Preparation is the golden key. Movie-goers and readers of

detective fiction are likely to suppose that successful cross-examination is the product of intuition, inspiration, and flashes of telepathic insight. . . . Today the stress is upon thorough preparation. . . .”

**Diligence Must Be a Requirement for Admission of Evidence
Despite Lack of Notice Under 35 U. S. C. 282.**

The above and other reasons behind the law necessitate a holding that *diligence*, not merely substantive merit, must be essential to admission of evidence despite lack of notice under 35 U. S. C. 282. If substantive merit alone were enough, a party would risk nothing by failure to give the statutory notice—whether such failure were intentional or were the result of grossly negligent and dilatory trial preparation. If such party’s evidence proved to be persuasive, he would win, and if not, he would have lost nothing by his failure to give notice. The statute would be emasculated.

Defendant, on page 15 of his brief, makes reference to the analogous situation in which an attempt is made to re-open a case under Rule 59, Federal Rules of Civil Procedure, because of newly discovered evidence. With relation to such rule the *courts* have imposed the requirement of *diligence*. In Moore, Federal Practice and Procedure, Volume 6, page 3785, it is stated that: “To warrant a new trial the . . . movant must have been excusably ignorant of the facts, *i. e.*, the evidence must be such that it was not discoverable by diligent search.”

Also, in Federal Practice and Procedure, Rules Edition, Barron and Holtzoff, Volume 3, Section 1305, pages 238-239, it is stated relative to Rule 59 that “The movant for a new trial must show due diligence in discovering such evidence. He is required to rebut the presumption that there has been a lack of diligence.”

Some of a long line of cases supporting the above quoted statements are as follows: *Toledo Scale Co. v. Computing*

Scale Co., 261 U. S. 399, 43 S. Ct. 458, 67 L. Ed. 719 (U. S. Sup. Ct. 1923); *Norwich Union Fire Ins. Soc., Limited v. Glasser*, 224 F. 2d 385 (C. A. 9, 1955); *United States v. Bransen*, 142 F. 2d 232 (C. A. 9, 1944); *Silva v. United States*, 38 F. 2d 465 (C. A. 9, 1930); *Twenty-One Mining Co. v. Original Sixteen to One Mine*, 265 F. 469 (C. A. 9, 1920); *General Electric v. Minneapolis Honeywell*, 35 Fed. Supp. 35 (D. C. N. Y., 1940), Revd. on other gnds, 118 F. 2d 278.

The situation relative to *Jules D. Gratiot, et al. v. Farr Company*, cited by Defendant on page 15 of his brief, is not reported and is not fully known to Plaintiff. Plaintiff has, however, ascertained from attorneys involved in that case that a showing of diligence was required.

Defendant Was Not Diligent.

That Defendant in this action was not diligent, but instead was grossly dilatory and negligent in his trial preparation over a period of many months, was pointed out in our opening brief at pages 34-36. Also, Defendant and his present attorney were not diligent (our opening brief, p. 39) in giving to Plaintiff what notice was actually available after the evidence was discovered—apparently as the result of a flurry of last-minute activity. *Defendant does not even claim to have been diligent.*

The trial judge, in admitting the un-noticed evidence, ignored all of the above-stated considerations. Instead, he apparently thought that justice would be done if he believed the substantive evidence [Tr. p. 499]. This, it is respectfully submitted, was like thinking that an illegal search and seizure is all right in any situation in which marijuana is discovered.

**Defendant Should Not Be Permitted to Escape
the Consequences of His Lack of Diligence.**

Defendant, in his brief, makes repeated attempts to put the shoe on the other foot and make Plaintiff appear in a bad light. He says that he was “forced” to trial (p. 12) before he was fully prepared—but this was nineteen months after the action was filed and over three years [Tr. pp. 27-28] after Defendant received written notice of infringement. He also intimates (His Brief, pp. 12-13) that Plaintiff should have moved for a continuance when the Alabama Street plant was first mentioned, and that the objection is waived because of Plaintiff’s failure to so move. The answer to this is that Defendant had cried “wolf” before and failed to back it up, and Plaintiff had every reason to suppose that this was merely another attempt at stalling. Furthermore, and most importantly, it is a *non sequitur* to say that Plaintiff “waived” a rule designed to prevent delay (*The Philadelphia and Trenton Railroad Co. v. Stimpson, supra*) by failing to ask for a delay.

Finally, Defendant asserts (His Brief, p. 12) that Plaintiff was not prejudiced since he could have called the witnesses back for additional cross-examination. That this would not have removed the prejudice (even if the trial judge would have permitted it, and even if the witnesses could have been enticed back into the jurisdiction of the trial court) is believed to be clear from the following statement of Judge Stone in *State v. Saporen*, 205 Minn. 358, 285 N. W. 898 (1939): “The chief merit of cross-examination is not that at some future time it gives the party opponent the right to dissect adverse testimony. Its principal virtue is in its immediate application of the

testing process. Its strokes fall while the iron is hot. False testimony is apt to harden and become unyielding to the blows of truth in proportion as the witness has opportunity for reconsideration and influence by the suggestions of others, whose interest may be, and often is, to maintain falsehood rather than truth." Thus, delayed cross-examination would have been relatively ineffective and, again, would have been contrary to the statutory purpose of preventing delay.

Summary.

To summarize, the trial judge did not exercise any discretion at all relative to the procedural statute here under consideration. Instead, he merely substituted his own beliefs as to the merits of Defendant's substantive defense. The trial judge gave no consideration to the questions of diligence by Defendant, or by his present counsel who failed to give Plaintiff what notice was available [Tr. pp. 157 and 160] and thus afford Plaintiff some chance to conduct an effectual cross-examination based on studied knowledge of the numerous shop drawings and orders in evidence. Furthermore, as stated in our opening brief at pages 40-42, the trial judge was acting under a misapprehension as to the effect of expiration of the patent.

Good judicial precedent should give to future defendants in patent cases an incentive to be reasonably diligent in their trial preparation—to the end that litigation be shortened and not protracted as the present case has been. It is pointed out that if the present Defendant is not caused to suffer detriment as the result of his actions, future defendants in other patent cases will be able to flout the

statute with impunity, and defeat the public interest in shortening litigation. Any hardship in a particular case should not weigh against the sound principle that non-diligent defendants should be penalized and litigation consequently shortened, to the benefit of the public (*Toledo Scale Co. v. Computing Scale Co.*, *supra*, 261 U. S. 399 at 424-425).

The public policy of shortening litigation, and in providing fair hearings, is in no sense outweighed by the policy expressed in the *Hycon* case (*Hycon v. Koch*, 219 F. 2d 353), cited by Defendant on page 11 of his brief. In that case a *newly issued* patent was ruled upon, in a summary judgment, without benefit of any actual trial. In the present case an *expired* patent was the subject of an extended trial, and the question presented relates to failure by one party to comply with an express statute. No third party will be affected, as to his future conduct or liability for future actions, by the outcome of the present litigation. If the Alabama Street Plant were an anticipation, any persons who infringed the present patent before it expired would have a perfect defense to any possible future suit by Plaintiff. Also, as emphasized in our opening brief at page 37, the very defense which Defendant is trying to raise is anomalous, and contrary to the basic public policy of promoting the progress of the arts by rewarding inventors who *inform* the art as to their inventions.

The above considerations demand permanent exclusion of all evidence relative to the Alabama Street plant.

POINT IV.

The Trial Court Erred in Permitting Introduction of the Documentary Evidence.

In our Main Brief, pages 43-46, we explained that Defendant's Exhibits A and F to P, inclusive, were identified as papers found in the files of Bodinson Mfg. Co., and that this is not enough to render them admissible.

Defendant agrees (His Brief, p. 13) "That mere presence in the files does not render these documents admissible." In the face of his admission that the witness Bodinson was not with the company prior to 1940 and that the documents bear dates around 1931, Defendant baldly argues "That the evidence establishes that the documents were made in the regular course of business and it was the regular course of business to make such records at the time of the act, transaction, occurrence or event." What evidence? Defendant doesn't identify it. Certainly it wasn't the testimony of Bodinson who admitted that he had nothing to do with the documents, or company policy, prior to 1940. Bodinson did not and could not have testified that *such* documents were made in the regular course of business at the time in question, and he certainly NEVER TESTIFIED THAT DEFENDANT'S EXHIBITS A AND F-P WERE MADE IN THE REGULAR COURSE OF BUSINESS. This is because he wasn't around at the time alleged or for many years thereafter.

Relative to page 14 of Defendant's brief, first two paragraphs, it was *not* established that the organization constantly followed the same record keeping system. Bodinson, the only witness, was not present during *nine* intervening years. Also, we are not talking about General Motors Corporation, but about a new local company founded only eleven years [Tr. p. 548] before the time in question.

Defendant seeks to ignore that these exhibits purport to be nothing more than indications of what someone might have been proposing for future action. He tries to bring them into the class of documents, ledgers, books of accounts and the like, which have been made exceptions to the hearsay rule because they are objective "observations" of current or past events.

Defendant cites *New York Life Ins. Co. v. Taylor* (C. A., D. C., 1944) 147 F. 2d 297, as authority for admitting the exhibits. Quite the contrary is true. In that case the Court EXCLUDED the records, psychiatric reports, because they were not an "automatic reflection of observations." The following excerpts from the Opinion on Rehearing in that case appear to be particularly pertinent.

"The records offered here are not the kind of entries which are admissible under the established principles of the Shop Book exception to the hearsay rule. Such records must be those which are a product of routine procedure and whose accuracy is substantially guaranteed by the fact that the record is an automatic reflection of observations."

"In other words, it is not the absence of a motive to misrepresent which is the basis of the Shop Book exception to the hearsay rule. Purely clerical entries come within the rule regardless of the fact that the party making them has an interest in what they may be used to prove. Conversely *where the accuracy of the entries depends on opinion, conjecture or judgment in selecting the particular entries from a larger mass of data which some other observer might consider equally important*, the entries are not within the Rule regardless of motive."

"Today every great corporation is making thousands of records, obtaining credit information, making psychological examinations of its employees, hiring efficiency experts

and recording the activities of its personnel. To admit this potpourri on the sole tests of regular recording and absence of motive to misrepresent would be a drastic impairment of the right of cross-examination. In a criminal case it is doubtful whether such a deprivation of the right of the accused to be confronted with the witnesses against him would be constitutional.”

Defendant also cites for authority the case of *Ettelson v. Metropolitan Life Ins. Co.* (3 Cir., 1947), 164 F. 2d 660, although we are unable to understand why. In that case the person who made and kept the records was called as a witness.

POINT V.

Defendant's Infringement Is Clear.

Regarding our assertion (p. 47 Our Main Brief) that infringement is clear, Defendant simply says “This is controverted,” (His Brief p. 15), without explanation as to where or why. As previously mentioned (This Brief pp. 9-10) he then goes on to argue that there is no infringement because the claims must be given a limited interpretation. He says, “If the claims are to be interpreted, as appellant contends, as limited to a device wherein the so-called premixing or intermingling occurs, then this is not present in appellee's structure according to appellant's own witness Pearman.”

Defendant is arguing for a double standard of claim interpretation, one standard for validity and a second for infringement. This he cannot do. Moreover the Trial Court was “convinced” that the Stanton apparatus had “commingling.” (This Brief pp. 3, 7.)

Other than the above, Defendant presents no disputed issue of fact on infringement. We submit that infringement can be and should be determined here in one single appeal.

POINT VI.

There Is No Necessity of a Remand to the Trial Court for Further Findings.

On pages 47 and 48 of our Main Brief we pointed out that it is to be presumed that the District Court did not believe the claims to be invalid over the prior art patents and publications because after stating that it was basing its decision on "all the evidence in the case," it based its Findings relating to the validity and infringement solely upon the Alabama Street plant.

Defendant does not attempt to explain this action on the Court's part. Instead, he merely says "The record is full of conflicting testimony on the presence or absence of invention and infringement," and must be remanded for appropriate decision. (His Brief p. 4.) But where are the conflicts on invention and infringement? Defendant doesn't point to a single one. Defendant's unsupported assertion (His Brief p. 15), that "questions of validity and infringement are disputed" does not make them so.

We respectfully urge that the record is complete and that no genuine issue as to any material fact is presented. Thus, if the complained of Findings and Conclusions are found to be in error, the mere fact that the District Court expressed no Findings on an issue does not necessitate a remand. (*Yanish v. Barber* (9 Cir., 1956), 232 F. 2d 939.

Even if there is a dispute as to validity or infringement, no remand is necessary where the record is complete and the situation is clear. (*Hazeltine Research, Inc. v. General Motors*, 170 F. 2d 6, 10 (C. A. 6, 1948), and *Moore's Federal Practice* (2d Ed.), Vol. 5 at p. 2662, both cited in *Yanish v. Barber*.)

Conclusion.

The final judgment of the District Court should be reversed and the case remanded with instructions to make an accounting of damages in favor of Plaintiff, The C. S. Johnson Company.

It is also respectfully urged that Plaintiff be awarded costs and attorney's fees. In this matter, the attention of the Court is invited to pages 650 and 651 of the Transcript.

Respectfully submitted,

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